

## REMARKS

### Introduction

Claims 1-27 were pending in this application.

Claims 17-19 were rejected under 35 U.S.C. § 102(e) as being anticipated by Rosser, U.S. Patent No. 6,446,261 (hereinafter "Rosser"). Claims 1-5, 15, and 16 were rejected under 35 U.S.C. § 103(a) as being obvious from Rosser in view of Klosterman et al., U.S. Patent No. 5,940,073 (hereinafter "Klosterman"). Claims 7, 8, and 11-14 were rejected under 35 U.S.C. § 103(a) as being obvious from Rosser and Klosterman further in view of Rothmuller, U.S. Patent No. 5,635,989 (hereinafter "Rothmuller"). Claims 9 and 10 were rejected under 35 U.S.C. § 103(a) as being obvious from Rosser, Klosterman, and Rothmuller further in view of Young et al., U.S. Patent No. 5,353,121 (hereinafter "Young"). Claims 20, 21, 24, and 25 were rejected under 35 U.S.C. § 103(a) as being obvious from Rosser in view of Dedrick, U.S. Patent No. 5,724,521 (hereinafter "Dedrick"). Claims 22, 23, 26, and 27 were rejected under 35 U.S.C. § 103(a) as being obvious from Rosser and Dedrick further in view of O'Flaherty et al., U.S. Patent No. 6,253,203 (hereinafter "O'Flaherty").

Applicant has amended claims 1, 3-15, and 20-24 to more particularly define the invention and to change the form of the claims. Applicant has also added new claims 28-31. No new matter has been added and the amendments and new claims are fully supported and justified by the originally filed specification. Applicant has also cancelled claims 2 and 17-19 without prejudice.

Reconsideration of this application in light of the amendments and the following remarks is hereby respectfully requested.

Applicant's Reply to the Rejection of  
Claims 1-16 Under 35 U.S.C. § 103(a)

Independent claims 1 and 15 were rejected under 35 U.S.C. § 103(a) as being obvious from Rosser in view of Klosterman. The Examiner's rejection is respectfully traversed.

Applicant's amended independent claims 1 and 15 are directed towards a method and a system for targeting advertisements to television viewers that have a television receiver and a television screen that displays an electronic program guide (EPG). Use of the receiver is monitored to develop a user profile based on viewer selections. A plurality of advertisements are received by the receiver and a sub-plurality of those advertisements are stored on the receiver depending on the viewer profile. Any one of the advertisements is selected from the sub-plurality of stored advertisements and the selected advertisement is displayed on the television screen in the EPG.

For example, each of the advertisements sent to the receiver may be compared with the user profile. The advertisements that match the user profile are stored on the receiver. Any one of the stored advertisements may then be selected (e.g., according to a rotation) to be displayed to the viewer within the EPG.

Rosser refers to a set-top device configured to use narrow casting techniques to "perform seamless insertion of still, animated, and live video indicia into the video stream in a way that can make the inserted indicia appear to the end user as if it were part of the original scene." Rosser, column 7, lines 41-45. The usage of the set-top device is monitored and a viewer profile is derived from the monitored usage. Advertisers may then target specific advertisements or indicia to be inserted into the broadcast video of viewers

based on their viewer profiles. For example, Rosser uses this narrow casting technique to insert one of several alternative versions of an "advertising sequence" into a video broadcast.

The Examiner contends that Rosser shows all of the elements of applicant's independent claims 1 and 15, except displaying an EPG on the television screen and displaying the advertisements within the EPG. To address these deficiencies in Rosser, the Examiner contends that it would be obvious to modify Rosser to include the EPG disclosed in Klosterman.

I. THE CITED REFERENCES DO NOT SHOW OR SUGGEST ALL OF THE ELEMENTS OF APPLICANT'S CLAIMS

Applicant respectfully submits that nothing in either Rosser or Klosterman shows or suggests all of the elements of applicant's amended independent claims 1 and 15. In particular, Rosser does not show or suggest storing a sub-plurality of transmitted advertisements at the receiver based on a viewer profile, selecting any one of the advertisements from the sub-plurality of advertisements, and displaying the selected advertisement on the television screen in an EPG, as required by applicant's independent claims 1 and 15.

The difference between Rosser and the claimed invention is subtle, but distinct. In Rosser, an advertisement is stored based on the user profile, but that particular advertisement is the only advertisement that will be displayed at a particular time and place as a seamless insertion of the video stream. See e.g., Rosser, column 13, lines 13-48. Applicant's invention is not limited as such; rather, claims 1 and 15 specify that any one of a sub-plurality of stored advertisements can be selected and displayed in the EPG screen. Thus, applicant's invention is not limited to displaying just one advertisement at

particular time and place. Indeed, though Rosser may store many advertisements based on the user profile, each such advertisement is designated for display at a particular time and place in the video stream. For example, assume the Rosser system stores advertisements A and B, with advertisement A designated to be displayed at the beginning of a program and advertisement B designated to be displayed at the end of the program. Though both advertisements A and B are stored, the Rosser system cannot select advertisement B for display at the beginning of the program. Disclosure of each element of applicant's independent claims 1 and 15 also cannot be found in Klosterman.

Therefore, whether taken alone or in combination, Rosser and Klosterman fail to show or suggest all of the features of applicant's independent claims 1 and 15.

## II. THE CITED REFERENCES TEACH AWAY FROM APPLICANT'S CLAIMED INVENTION

Further, applicant respectfully submits that Rosser teaches away from applicant's claimed invention. Rosser provides a system in which the narrow-cast advertisements are displayed "[a]t the appropriate time and place." Rosser, column 13, line 25. For example, as shown in FIG. 1 of Rosser, advertisement 58 is displayed over the tennis court of one video screen while a different advertisement 60 is displayed in the other video screen. Advertisements 58 and 60 were specifically intended to be narrow-cast into the video over the tennis court. Since the advertisements of Rosser are inserted at predetermined times and places, only the one version of each advertisement that matches the viewer profile is stored for each advertising sequence. Accordingly, Rosser teaches away from selecting any one of the advertisements from the sub-plurality of advertisements

stored at the receiver depending on a viewer profile, as required by applicant's independent claims 1 and 15.

### III. THE EXAMINER HAS FAILED TO PROVIDE MOTIVATION TO COMBINE THE REFERENCES

In order to establish a *prima facie* case of obviousness based on a combination of references, there must be "some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art." MPEP, at § 2143.01. Applicant respectfully submits that the Examiner has failed to fulfill the requirement of presenting an "objective teaching . . . or . . . knowledge generally available to one of ordinary skill in the art that would lead that individual to combine the relevant teachings of the references," In re Fine, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). See In re Rouffet, 149 F.3d 1350, 1355 ("When a rejection depends on a combination of prior art references, there must be some teaching, suggestion, or motivation to combine the references"). "Broad conclusory statements regarding the teaching of multiple references, standing alone, are not 'evidence' of a motivation to combine. In re Dembiczak, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999), abrogated on other grounds by In re Gartside, 53 USPQ2d 1769 (Fed. Cir. 2000).

In support of the combination of Rosser with Klosterman, the Examiner states that:

It would have been obvious at the time to a person of ordinary skill in the art to modify the method disclosed by Rosser and Klosterman to include displaying the advertisements on the screen simultaneously with the EPG, as taught by Klosterman, for the benefit of providing advertisers the additional opportunity to display their promotional material to viewers within the viewer's program guide.

Applicant respectfully submits that this is not sufficient motivation to combine Rosser and Klosterman. Rather, the Examiner has merely listed an alleged benefit of applicant's novel invention as motivation to combine the references instead of pointing to an objective teaching in either Rosser or Klosterman that would lead one of ordinary skill in the art to combine these references. Namely, the Examiner has indicated that there is a benefit to displaying promotional information within a program guide, but not why one of ordinary skill in the art would be motivated to display promotional information within a program guide when Rosser already refers to another suitable technique for displaying promotional information, i.e., narrow casting. These two divergent advertising techniques cannot be combined in the manner suggested by the Examiner without an objective teaching in either Rosser or Klosterman that would lead one of ordinary skill in the art to combine these references. Accordingly, the Examiner has not provided sufficient motivation to combine Rosser or Klosterman.

#### IV. THE EXAMINER HAS EMPLOYED HINDSIGHT RECONSTRUCTION IN COMBINING THE REFERENCES

Applicant respectfully submits that the Examiner has employed hindsight reconstruction in combining the references. With the knowledge of applicant's novel system for targeting advertisements to television viewers within an EPG, particular features of the prior art were identified for use in rejecting applicant's invention. This technique has long been held invalid by the courts at creating a *prima facie* case of obviousness. See In re Fine, 5 USPQ2d at 1600. ("One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.").

The Examiner has used applicant's own invention as a bridge between Rosser and Klosterman. In doing so, the Examiner has demonstrated mere hindsight reconstruction, the very "syndrome" that the requirement for objective evidence is designed to combat, and the rejection is therefore insufficient as a matter of law. See In re Dembiczak, 50 USPQ2d at 1617-1618.

#### V. CONCLUSION

Accordingly, applicant respectfully requests that the rejection of amended independent claims 1 and 15 over Rosser in view of Klosterman under 35 U.S.C. § 103(a) be withdrawn.

Applicant also respectfully requests that claims 3-14, 16, 28, and 29 be allowed, at least because they depend from allowable independent claims 1 and 15.

#### Applicant's Reply to the Rejection of Claims 20-27 Under 35 U.S.C. § 103(a)

Claims 20, 21, 24, and 25 were rejected under 35 U.S.C. § 103(a) as being obvious from Rosser in view of Dedrick.

Applicant has amended independent claims 20 and 24 to include all of the features of applicant's amended independent claims 1 and 15. For at least this reason, applicant respectfully requests that the rejection of applicant's amended independent claims 20 and 24 also be withdrawn.

Applicant also respectfully requests that claims 21-23, 25-27, 30, and 31 be allowed, at least because they depend from allowable independent claims 20 and 24.

New Claims 28-31

Applicant has added new dependent claims 28-31 in which the advertisement is selected from the sub-plurality of stored advertisements according to a rotation.

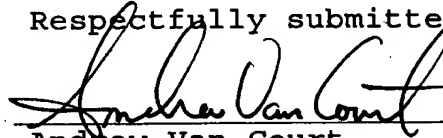
Applicant respectfully submits that Rosser and Klosterman, whether taken alone or in combination, do not show all of the elements of applicant's new claims 28-31.

Accordingly, for at least for this additional reason applicant respectfully submits that new claims 28-31 are in condition for allowance.

Conclusion

The foregoing demonstrates that this application is in condition for allowance. Accordingly, reconsideration and allowance of this application are respectfully requested.

Respectfully submitted,



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